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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,738	06/08/2001	Boris Viktorovich Moiseev	MOISEEV ET AL-1 PCT	9616

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

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10/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/857,738	Applicant(s) MOISEEV ET AL.	
	Examiner Michael Bekerman	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 41, this claim recites the new limitation "said device for generating being programmed with capabilities for forming of said set according to preliminary chosen procedure of different sequencing of the provided information and advertising information or of simultaneous presentation of requested and advertising information". Applicant claims there is support in the specification in the fourth paragraph of the detailed description (preferred version). This paragraph recites "In difference to well-known networks where a server transmits the information the user is interested in according to his request without conversation (?), that is the way it is stored in the server, this system allows using the device 3 for generating a set of requested and advertising information before it is provided to the user". Applicant argues that the word "preliminarily" was lost in translation from the original foreign

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specification. Examiner, however, still sees no indication that this equates to a preliminary "chosen procedure of different sequencing". The cited paragraph appears to only specify that requested and advertising information is simply gathered before being sent, and the addition of the word preliminarily to the paragraph does not appear to change this meaning.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. As best understood, Claims 41-44, 46-56, and 58 are rejected under 35

U.S.C. 102(e) as being anticipated by Gerszberg (U.S. Patent No. 6,292,210).

Gerszberg shows an advertising information system that includes all of the limitations recited in the above claims.

Regarding claims 41, 42, 50 and 58, Gerszberg teaches a system including a user's device (which could be any number of devices) connected via a connection unit to a memory device (ISD, which examiner considers to act as a server) (Column 5, Lines 35-40). Also included into said system is a device for generating a set of requested information and advertising information (television, which examiner also

considers to be an information display board) (Column 9, Lines 27-33). It is inherent that a device for displaying advertisement information (such as a television) would also have an entry for inputting advertisement information. Examiner considers the memory device above to be an advertising information memory device. Examiner considers the set-top box to be a microprocessor (Column 9, Lines 27-38). Examiner reads the broad meaning of "change of sequencing to encompass a change in the order of provided information or advertising. Thus, a television remote control as referenced by Gerszberg (Column 9, Lines 31-33) would be capable of changing the channel, which is a change in the order that information is provided, and thus represents a change in the sequencing of provided information (or advertisements). Further, Gerszberg teaches the system as incorporating components such as a VCR (Column 9, Lines 35-38). VCR's are inherently capable of arranging a sequencing of programming in whichever fashion the user chooses. This reads on the "preliminary chosen procedure of different sequencing".

Regarding claims 43 and 44, these claims merely specify intended use. The television of Gerszberg is capable of showing a video display of requested information (television programming) and advertising information simultaneously (Column 4, Lines 5-13 and Column 12, Lines 13-16 and 38-40).

Regarding claims 46-49, Gerszberg shows a user device as being any of the following: a computer (Column 5, Lines 35-38), a telephone or videophone (Column 5, Lines 35-38), or a remote control/phone combination unit (Column 3, Lines 2-4).

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Gerszberg also teaches a printer as being connected to a videophone (Column 7, Line 55). Claim 28 merely specifies intended use.

Regarding claim 51, Gerszberg teaches the ISD to act as a multiplexer (Column 2, Lines 59-60).

Regarding claims 52-56, Gerszberg teaches the communication network as being a telephone network (the communication in this case involves the transmitting of audio to the television) (Column 3, Lines 4-10). Gerszberg also teaches a wide area network such as the Internet as being available (Column 7, Line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Gerszberg (U.S. Patent No. 6,292,210). Gerszberg teaches both the requested and advertising information as having video, but doesn't specify the advertisements as having sound. Official notice is taken that it is well known to add sound to a video advertisement shown on a television. Reference is drawn to everyday television commercials as having both video and audio. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include audio in the

advertisements of Gerszberg. This would allow for a better understanding of the advertisement, as it could be heard as well as seen.

4. **Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg (U.S. Patent No. 6,292,210) in view of Boylan (U.S. Pub. No. 2004/0194138).** Gerszberg doesn't specify the advertisements shown on the television as being selectable. Boylan teaches an interactive program guide on a television that has user-selectable advertisements (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow users to select which advertisements to view. This would allow for more sales to be made, as users are only looking at advertisements that interest them.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB

Jeffrey P. Carlson
JPC
Primary Examiner 3622